

REMARKS

Applicant wishes to thank the Examiner for reviewing the present application and the claims presented by Applicant. Applicant also wishes to thank the Examiner for granting an interview via telephone by Applicant's patent agent, Sean X. Zhang, conducted on June 8, 2009.

Claims 14-56 are pending and stand rejected. During the telephone interview, the set of claims filed on January 23, 2009 and Gross (U.S. Patent Application Publication No. 2004/0111478), in particular, its paragraph [00263], were discussed.

Applicant amends claims 14, 18, 24, 37, 47 and 52 to use "available to the sender" instead of "acceptable to the receiver subsystem" (see, e.g., paragraph [0042] of the specification). Claims 14, 18, 24, 37, 47 and 52 are also amended to further clarify that the sender subsystem is also configured to add a new category to the listing of receiver's categories (see, e.g., paragraph [0031] where automated negotiation is discussed and paragraph [0042] which provides an example of adding a new category in an automated negotiation with the receiver subsystem). In addition, claims 14 and 24 are amended to recite a storage module or storage device and claim 18 is also amended accordingly in view of this amendment to claim 14.

No new subject matter is introduced by way of these claim amendments. Entry of the amended claims is respectfully requested.

Claim Rejections – 35 U.S.C. §101

In the Office Action, the Examiner rejected claims 14-36 under 35 U.S.C. §101, on the ground that the claims were directed to software *per se*. The Examiner, however, also indicated that the rejection would be overcome if independent claims 14 and 24 were amended to include a storage unit as part of the system recited in these claims. While not necessarily concurring with the Examiner but solely in order to expedite the prosecution of this application, claims 14 and 24 have been amended as suggested by the Examiner.

Applicant also wishes to note that, as previously noted in the response filed on January 23, 2009, the system described also includes a communication link between the sender subsystem and receiver subsystem, a feature already recited in independent claims 14 and 24. Further, Applicant describes the sender subsystem and receiver subsystem as "automated systems" (see paragraph [0025]), which clearly indicates to one skilled in the art that such a

system is not software *per se*, which cannot automate anything by itself. To one skilled in the art, the software systems referenced by the Examiner are software systems executing on suitable hardware. An automated system, either a sender subsystem or a receiver subsystem, refers to a system that includes both the software system and the underlying hardware upon which the software system executes.

Accordingly, it is respectfully submitted that Applicant's claims 14-36 are not directed to software *per se* and meet the subject matter requirement under 35 U.S.C. §101. The withdrawal of the Examiner's rejections of claims 14-36 is respectfully requested.

Claim Rejections – 35 U.S.C. §112

In the Advisory Action mailed on October 23, 2008, the Examiner advised that claim rejections made under 35 U.S.C. §112 to claims filed on September 29, 2008 would be withdrawn if a Request for Continued Examination was filed. Applicant filed a Request for Continued Examination and also amended the claims to further define in the claims the term "negotiation", as suggested by the Examiner. In response to the Examiner's rejection of the claims under 35 U.S.C. §112 made in the Office Action, Applicant provides the following comments.

Applicant respectfully disagrees that the specification does not provide the disclosure in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention. The Examiner seems to be of the view that the specification does not describe an interactive negotiation process, or that there is no description of a sender subsystem proposing an alternative category when a first identified category is deemed not acceptable, or that the receiver subsystem providing an indication to the sender subsystem that a category is not acceptable.

Notwithstanding that these issues have already been discussed in the response filed on September 29, 2008, Applicant notes again that such an interactive negotiation process is described throughout the specification. For example, Fig. 2 depicts an example of negotiation of a category when a user composes and sends a message. In paragraphs [0026] and [0033], it is described that the sender's and the receiver's preferences of categorization, i.e., their categories, are united as the message is composed and sent, and that the negotiated categories are categories shared by the receiver and the sender, as determined by the sender and receiver subsystems. As further described in paragraph [0034], as a sender enters more information when composing the message, the sender subsystem can use the additional

information to update an already negotiated category (i.e., to propose the update and to agree upon the updated category) or propose a new category (also shown in Fig. 2). In paragraph [0033] and [0034], in connection with Fig. 2, Applicant also describes the sender agent first initiates and then completes the negotiation process with the receiver agent prior to sending the message. It also describes that during the negotiation process, there is either a simple or complex interaction between the sender (i.e., a user) and a sender agent (the sender subsystem). In paragraph [0031], Applicant also describes that negotiation can be guided with input from the sender. All of these are different aspects of an interactive negotiation process. In paragraph [0042], Applicant also provides an "interactive example" of a sender selecting an active (negotiated) category to complete a negotiation process.

Figs. 9-11 depict further examples of such interactive negotiation initiated by a sender agent. For example, in paragraph [0042] and in Fig. 9, Applicant describes and illustrates categories that are negotiated by the sender agent and receiver agent behind the scene. As already noted, these negotiated categories are categories already agreed upon and shared by both sender and receiver agents in the negotiation (paragraphs [0026] and [0033]). These negotiated categories are presented for user selection in a drop down list. As shown in Fig. 9 and explained in paragraph [0042], not all of the listed categories are available to the sender, i.e., some would not be accepted by the receiver subsystem if selected by the sender. To categorize the message, the sender may propose a different category or simply create a new category (in the receiver's list of categories) in order to reach common ground between the sender and receiver agents and to complete the negotiation. Fig. 2 also shows and paragraph [0034] describes that sender's categorization may be influenced by information in the body of the message or the subject heading provided by the sender. As the sender subsystem receives more information from the sender, although a category may already have been negotiated, the sender subsystem may use the additional information to negotiate a new category or update the category negotiated, i.e., by proposing the new category or the updated category and have it agreed upon by the receiver subsystem.

To summarize, Applicant's specification does describe an interactive negotiation process initiated by the sender agent, in which the sender agent proposes a category. The proposed category may be one available to the particular sender (or "active category"), which may be the one agreed upon by both sender and receiver agents ("common ground" reached), or not available to the sender and therefore, in which case an alternative or new category will be

proposed in order to reach "common ground". Applicant's specification does provide adequate disclosure in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention. The amended claims are fully supported by the disclosure and no new subject matter is introduced by way of the claim amendments.

Nevertheless, for consistency with the terms used in the specification and as suggested by the Examiner during the telephone interview, Applicant also amends claims 14, 24, 37, 47 and 52 to use the term "available to the sender", replacing "acceptable to the receiver subsystem." It is respectfully submitted that the claims in their current form fully comply with 35 U.S.C. §112. The withdrawal of claim rejections under 35 U.S.C. §112 is respectfully requested.

Claim Rejections – 35 §103

(a) Claims 14-17, 20-43, and 47-56

The Examiner rejected claims 14-17, 20-43 and 47-56 under 35 USC §103(a) as being obvious over Schiavone (U.S. Patent Application Publication No. 2002/0120600), in view of Gross (U.S. Patent Application Publication No. 2004/0111478).

Claims 14, 24, 37, 47 and 52 are independent claims. Claims 15-17, 20-23 depend from claim 14. Claims 25-36 depend from claim 24. Claims 38-43 depend from claim 37. Claims 48-51 depend from claim 47. Claims 53-56 depend from claim 52. Independent claims 14, 24, 37, 47 and 52 will be first considered below.

Applicant notes that independent claims 14, 24, 37, 47 and 52, as amended, all recite the negotiation of a category between the sender subsystem and the receiver subsystem that is initiated by the sender subsystem and the association of the message with the negotiated category. For example, both claims 14 and 24 require, among others, the sender subsystem to initiate a categorization negotiation process with the receiver subsystem and to associate the negotiated category with the message. Similar claim limitations, with varying level of detail, are also required by other independent claims.

The Examiner attempts to show in the Office Action that Schiavone teaches a negotiation process initiated by the sender subsystem and that Gross discloses a sender subsystem associating a category with a message and also being configured to propose for addition of new categories to receiver's categories. As explained in the previous responses,

Schiavone and Gross, either alone or in combination, do not contain the teachings as alleged by the Examiner. For example, Schiavone does not teach the initiation of a process to negotiate categorization. Indeed, as submitted earlier, which submission is incorporated by reference herein, Schiavone merely teaches publication of acceptable message type specifiers for a sender to select. Schiavone does not teach negotiation of these specifiers. Further, as submitted in previous responses, Schiavone does not teach message categorization, either. Paragraph [0051] in Schiavone cited by the Examiner actually teaches negotiation of delivery of e-mail messages, not a categorization negotiation, as the Examiner already noted in the Office Action.

During the telephone interview, the Examiner also suggested that paragraph [00263] of Gross may be interpreted as teaching the initiation of such a negotiation process. This will be addressed below together with the issue whether Gross teaches a receiver subsystem that permits the sender subsystem to add a new category to the receiver's list of categories.

Applicant's claims also require a receiver subsystem that is configured to permit the sender subsystem to add a new category to a listing of receiver categories. Applicant notes first that the Examiner conceded in the Office Action that Schiavone has no disclosure of a receiver subsystem that permits the sender subsystem to propose and add new categories. The Examiner cited Gross as teaching this feature. The Examiner cited paragraph [0263] in Gross and asserted "Gross further discloses permitting the sender subsystem to propose new categories for adding to a listing of receiver categories [0263]". For easy reference, paragraph [0263] from Gross is reproduced below.

It will be appreciated that new processing criteria can be continuously added, deleted, or changed by a recipient or a 3rd party, such as an administrator, on behalf of the recipient. It will also be appreciated that a sender can make suggestions to a receiver--by, for example, means of a message--to add processing criteria not yet known to the receiver, which the receiver can confirm to accept or reject. (Emphasis added)

Gross only discloses that a "sender" may suggest a new category, which the receiver may accept or reject. However, "sender" as used by Gross here is a user ("User 1", see [0261], Gross), i.e., a human operator, not a sender subsystem as required by Applicant's claims. Similarly, "recipient" of Gross also refers to a user ("User 2", see [0261], Gross), another human operator. The acceptance or rejection of the sender's suggestion must be confirmed by the

receiver. Applicant has studied carefully the entire disclosure of Gross and is unable to locate any teaching in Gross of a receiver subsystem that permits new categories to be added by a sender subsystem. The Examiner also was not able to identify any other passages in Gross disclosing such a receiver or sender subsystem as required by Applicant's claims. What is described in paragraph [0263] corresponds to a scenario that always require the action of the receiver (user), therefore his/her availability. This is a limitation that Applicant's invention intends to overcome! See paragraph [0006] of Applicant's specification.

In addition, in response to the Examiner's suggestion that Gross may disclose a negotiation process initiated by the sender subsystem, relying on its paragraph [00263], Applicant notes that it is the receiver (a human operator) who is accepting or rejecting a suggestion from a sender (another human operator). This is entirely different from the negotiation between two subsystems required by Applicant's claims. Further, Applicant notes that Gross merely discloses one way of adding or rejecting new processing criteria, not a process to categorize the message to be transmitted. The suggestion relates to the set of processing criteria but not how any particular processing criteria is to be associated with the message to be sent. Finally, as submitted previously, a processing criteria as taught by Gross tells the system how to process a message ("the message is processed in accordance with processes identified by the tags", [0044], Gross; "These processing criteria are unique tags associated with the processing criteria," [0042], Gross). This is different from a category assigned to a message that classifies the category to which the message belongs.

Further, even if suggesting a new processing criteria to the receiver may be interpreted as suggesting a new category, which Applicant disagrees, the difference between what is claimed and what is taught by Gross still remains: a receiver (a human operator) is not a receiver subsystem and a sender (a human operator) is not a sender subsystem. There is no teaching whatsoever in Gross on how to incorporate this functionality in its sender subsystem or receiver subsystem (both corresponding units in Gross yet to be identified by the Examiner). Given that Gross describes telephone communication as one of the preferred embodiments (see, e.g., its second embodiment summarized at paragraph [0052] and further described in detail at paragraphs [0164] to [0171]), it is arguable that Gross already provided an implementation of this method: via telephone conversation between the receiver (a human operator) and the sender (another human operator). No need to provide any sender subsystem or receiver subsystem to automate the process would ever arise.

The Supreme Court in *KSR v. Teleflex* has recently clarified the determination of the question of obviousness. The guidance of the Supreme Court has been embodied in the guidelines for patentability in MPEP. In *KSR*, the Court held that, to find obviousness, it is necessary to resolve the Graham factual inquiries (or "Graham factors") by articulating the following:

1) a finding that the prior art included each element claimed, although not necessarily in single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference.

2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods and that in combination, each element merely would have performed the same function as it did separately;

3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable. (emphasis added).

As discussed above, Schiavone and Gross, either alone or in combination, at least do not disclose a receiver subsystem that permits the sender subsystem to add a new category to the listing of receiver's categories as recited in claim 14. There is also no teaching in either Schiavone or Gross that the sender subsystem initiates a categorization negotiation with the receiver subsystem, also required by claim 14. Given these differences, the Examiner is yet to establish that one skilled in the art, without having first consulted Applicants' specification, would provide the sender system that initiates categorization negotiation and the receiver subsystem that permits the sender subsystem to add new categories, both required by claim 14. It is therefore respectfully submitted that the Examiner is yet to discharge the burden of making a finding that the prior art included each element claimed, which is only the first step required by the Graham factual inquiries.

Accordingly, notwithstanding the submissions already made in the previous responses, which are repeated here and incorporated by reference, for at least the reasons alone discussed above in this response, it is respectfully submitted that it is not proper for the Examiner to assert that the subject matter of claim 14 would have been obvious. Further, even if the combination of references relied upon by the Examiner was made, such a combination would not teach the claimed invention. Further modifications to the combination would be required, which modifications also have not been established to be obvious. The withdrawal of rejections of claim 14 on obviousness ground is respectfully requested.

Inasmuch as claims 15-17, 20-23 depend from claim 14 and incorporate by reference all claim limitations of claim 14, it is respectfully submitted that, at least for the reasons discussed above in connection with claim 14, the Examiner's conclusion of obviousness of these claims also cannot be reasonably supported by the teachings of Schiavone and Gross. The withdrawal of rejection of claims 15-17, 20-23 is also respectfully requested.

Similarly, notwithstanding the submissions already made in the previous responses, which are repeated here and incorporated by reference, as other independent claims, namely claims 24, 37, 47 and 52, all require such a sender subsystem and such a receiver subsystem as required by claim 14, it is respectfully submitted that at least for the additional reasons discussed above in connection with claim 14 in this response, it is not proper for the Examiner to assert that the subject matter of any of claims 24, 37, 47 and 52 would have been obvious. The withdrawal of rejections of claims 24, 37, 47 and 52 is also respectfully requested.

In addition, inasmuch as claims 25-36 depend from claim 24 and incorporate by reference all claim limitations of claim 24, claims 38-43 depend from claim 37 and incorporate by reference all claim limitations of claim 37, claims 48-51 depend from claim 47 and incorporate by reference all claim limitations of claim 47, and claims 53-56 depend from claim 52 and incorporate by reference all claim limitations of claim 52, the withdrawal of rejections of claims 25-36, 38-43, 48-51, and 53-56 is also respectfully requested.

(b) Claims 18, 19, and 44-46

The Examiner rejected claims 18, 19, and 44-46 under 35 USC §103(a) as being obvious over Schiavone and Gross, in view of Koenig (U.S. Patent Application Publication No. 2002/0120748).

As discussed above in connection with claim 14, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 14. This is not cured by Koenig. Therefore, Schiavone, Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 14.

Claims 18 and 19 depend from claim 14 and incorporate by reference all claim limitations of claim 14. For at least the same reasons discussed above in connection with claim 14, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig, and that a prima facie case of obviousness has not been established. The withdrawal of rejection of claims 18 and 19

is respectfully requested.

Claims 44-46 depend from claim 37 and incorporate by reference all claim limitations of claim 37. As discussed above in connection with claim 37, Schiavone and Gross, either alone or in combination, do not teach each and every claim limitations of claim 37. This is not cured by Koenig. Therefore, Schiavone, Gross and Koenig, even in combination, also do not teach each and every claim limitations of claim 37.

For at least the same reasons discussed above in connection with claim 37, it is respectfully submitted that the Examiner's conclusion of obviousness cannot be supported by the cited references, namely Schiavone, Gross and Koenig. The withdrawal of rejection of claims 44-46 is respectfully requested.

In view of the foregoing, the Applicant respectfully submits that claims 14 to 56, as amended, are all novel, non-obvious and are all allowable over the references cited. The Applicant respectfully requests the reconsideration of the rejections of these claims and allowance of the present application.

The Examiner is invited to contact the undersigned by telephone to discuss this case further, if necessary, at (416) 863-5839.

Respectfully submitted,



Sean X. Zhang, Ph.D.
Agent for Applicant
Registration No. 56,058

Date: June 9, 2009

BLAKE, CASSELS & GRAYDON LLP
199 Bay Street
Suite 2800, Commerce Court West
Toronto ON M5L 1A9
Canada

Tel: 416-863-5839
Fax: 416-863-2653